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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,729	02/06/2004	Andrew R. Forrest	FPC001USU	8604
45180	7590	07/19/2005	EXAMINER	
GRIMES & BATTERSBY, LLP 488 MAIN AVENUE, THIRD FLOOR NORWALK, CT 06851			MENDIRATTA, VISHU K	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 07/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/773,729

Applicant(s)

FORREST ET AL.

Examiner

Vishu K. Mendiratta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8,10-13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8,10-13 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Note to applicant: Upon further search a new non-final action is being forwarded. Inconvenience is regretted.

Specification

1. Claim 15 objected to because of the following informalities:

A claim should be able to stand on its own.

In the absence of a proper environment such as a proper set up of the game apparatus, it is not possible to practice the claimed method.

Claim is absent of any distinction between movement rules of player pieces and non-player pieces. It is unclear why non-player pieces are provided.

It is also unclear where in the claimed method "robot cards" are used.

It is also unclear as to which piece enters the chamber, where are the tiles, etc.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 15 provides for the use of "robot card", "non-player pieces" but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

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Claim 15 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

4. Claims 1-4,8,10-13 rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder in view of Rosenwinkle (4569527).

Claims 1,2,10,13: Snyder teaches a game board (12), at least two player game pieces (33), a timing mechanism (24), Lockable mechanism (31), a set of tiles with printed matter (34) and a key (36) to open the mechanism .

Snyder also teaches a non-player game piece (29), capable of being placed on the board and also influencing the movement of game pieces (2:43-47). A non-player game piece is being interpreted as a piece that is not owed/controlled by any one player. It can also be interpreted as a game piece that is being commonly used by all players broadly and reasonably interpreting. Also a movement such as spinning by a spinner or a movement of rolling by a die can be interpreted as movement of a non-player piece broadly and reasonably interpreting. The claim does not however specifically limit the movement of such a non-player piece on a path of individual spaces.

Snyder teaches all limitations except that it does not teach keys printed on tiles.

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Rosenwinkle teaches a set of cards with keys printed on them (Fig.8, 11).

The only difference between claimed card and the card in applied reference resides in the meaning and information conveyed by the printed matter that and not considered patentable. In order to make the game attractive it would have been obvious to modify indicia on cards. One of ordinary skill in art at the time the invention was made would have suggested modifying game card indicia to promote a game.

Claim 3: Snyder teaches a die (37).

Claim 4: Changing shapes of playing pieces is aesthetical and do not change the game. In order to attract players, it would have been obvious to use various shapes of playing pieces.

Claim 8: Both lockable mechanism and timing device within the same game board unit (12,24,31).

Claims 11-12: Claims recite limitations intended use of the cards and do not further limit the apparatus. Any of the cards in Figs. 8-11 can be used for those purposes.

5. Claims 5-6 rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder in view Rosenwinkle and in further view of Bedford (US 2003/0085519 A1).

Claims 5,6: Snyder and Rosenwinkle teach a game board (12), at least two player game pieces (33) and a timing mechanism (24). Snyder teaches discrete spaces/chambers (14,19,20,21). Snyder teaches all limitations except that it does not expressly teach a non-player game piece with regards to its movement on a

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path of spaces. A non-player game piece is being interpreted as a piece that is not owed/controlled by any one player. It can also be interpreted as a game piece that is being commonly used by all players broadly and reasonably interpreting.

Also a movement such as spinning by a spinner or a movement of rolling by a die can be interpreted as movement of a non-player piece broadly and reasonably interpreting. The claim does not however specifically limit the movement of such a non-player piece on a path of individual spaces.

Bedford teaches a non-player piece (138) that influences movement of player pieces (134) (see paragraph 0064, the Malfoy movement influencing player pieces).

Art area of game board is a very competitive amusement area and in order to attract players it has been a common practice to provide playing pieces that affect other game pieces. In order to make the game attractive, it would have been obvious to provide such game pieces. One of ordinary skill in art at the time the invention was made would have suggested using game pieces influencing other game pieces.

Response to Arguments

6. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishu K. Mendiratta whose telephone number

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is (571) 272-4426. The examiner can normally be reached on Mon-Fri 8AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on (571) 272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Vishu K Mendiratta
Primary Examiner
Art Unit 3711

VKM
July 13, 2005